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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, QUANG N

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 05/19/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668,500

Applicant(s)

AMRO ET AL.

Examiner

Quang N. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 8, 10, 11, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 8, 10, 11, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

Detail Action

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/05/2004 has been entered.

Claims 1-4, 7-8, 10-11 and 14-15 have been amended. Claims 5-6, 9, 12-13 and 16-22 have been cancelled. Claims 1-4, 7-8, 10-11 and 14-15 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 3 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable**

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one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. Claims 3 and 11 recite that "... the search engine providing an advertisement to be displayed on the second computer system", wherein the second computer system is defined in claim 1 as a server including a search engine. There is no use for the search engine (server system) providing an advertisement to be displayed on itself because the client would not be able to see the advertisement along with the result set. Therefore, the examiner would interpret claims 3 and 11 as "... the search engine providing an advertisement to be displayed along with the result set on the client/user computer system".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

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directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-2, 7-8, 10 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Jain (US 6,480,853).

7. As to claim 1, Jain teaches a method comprising:

providing a first computer system including bookmarks (*user's list of bookmarked URLs stored within the client device 24 in Fig. 2*) (Jain, C2: L57-59 and C4: L24-33);

providing a second computer system including a search engine (*the server device 26 in Fig. 2 hosting a search engine configured to receive search requests, i.e., search terms from the client device 24*) (Jain, C4: 24-33);

providing a search term (*i.e., search request*) to the search engine via a communication network (Jain, C3: L8-10 and C4: L24-33);

providing an identifier for each bookmark (*i.e., URLs stored as bookmarks within the browser*) (Jain, C3: L8-10, C4: L24-33 and C6: L28-37);

the search engine receiving search term and identifier information identifying a computer system (*the search engine 26 receives a search/URL request containing a source address and a destination address, i.e., information identifying a computer system, from the client device 24*);

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the search engine searching a database using the search term and also searching websites associated with the bookmarks (Jain, C7: L13-37); and

the search engine providing results of searching the database and the websites to an identified computer system (*the URLs of Web pages and the user's bookmarks that satisfy the search request are then displayed to the user via the user's browser*) (Jain, C7: L13-37).

8. As to claim 2, Jain teaches the method of claim 1, further comprising:

the search engine providing results of the searching to one of the first system and a third computer system (*the URLs of Web pages and the user's bookmarks that satisfy the search request are then displayed via the user's browser*) (Jain, C7: L13-37).

9. As to claim 7, Jain teaches the method of claim 1, further comprising:

accessing a file that includes bookmarks (*the server accessing a cookie that lists the user's bookmarks could be generated when a search request is made by a user*) (Jain, C6: L38-49); and

creating the identifier in response to accessing the file (*i.e., the search engine is configured to receive and interpret the cookie and search the bookmarks contained there within to generate the result set*) (Jain, C6: L38-49).

10. Claims 8, 10 and 15 are corresponding system claims of method claims 1-2 and 7; therefore, they are rejected under the same rationale.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 3-4, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jain, in view of Himmel et al. (US 6,324,566), herein after referred as Himmel.**

13. As to claims 3-4, Jain teaches the method of claim 1, but does not explicitly teach the search engine using the search term and information from the identifiers to select an advertisement to be displayed with the results.

In the related art, Himmel teaches a method for Internet advertising via bookmark set based on client specific information (*i.e., client's search term/request*), wherein an advertisement (*e.g., banners/bookmark to web pages containing articles on such client search terms/requests/topics*) associated with the result would be selected, included, downloaded and displayed with the result set to the user (Himmel, C8: L40-53 and C10: L27-61).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Jain and Himmel for displaying an advertisement associated with the bookmark in response to displaying the result because such methods were conventionally employed in the art to allow the system to provide a new electronic advertising medium through a search engine site using the user stored bookmarks in order to save both user and server processing time and to provide users with additional valuable information and services related to the user's requested information/topic (Jain, C3: L8-19 and Himmel, C2: L45-56).

14. Claims 11 and 14 are corresponding system claims of method claims 3 and 4; therefore, they are rejected under the same rationale.

15. Applicant's arguments as well as request for reconsideration filed on 04/05/2004 have been fully considered but they are moot in view of the new ground(s) of rejection.

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16. A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Quang N. Nguyen


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER